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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,835	10/19/2001	Alex S. Taylor	110914	7065
27074	7590	09/29/2006	EXAMINER	
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			RIES, LAURIE ANNE	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 09/29/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/981,835  
Filing Date: October 19, 2001  
Appellant(s): TAYLOR ET AL.

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Jesse O. Collier  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12 June 2006 appealing from the  
Office action mailed 11 January 2006

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Price, Morgan N., et al, "Linking By Inking: Trailblazing in a Paper-Like Hypertext", ACM, 1998, pp. 30-39.

Golovchinsky, Gene, et al, "From Reading to Retrieval: Freeform Ink Annotations as Queries", ACM, 1999, pp. 19-25.

Lawton, Daryl T., et al, "The Knowledge Weasel Hypermedia Annotation System", Conference on Hypertext and Hypermedia, Proceedings of the Fifth ACM Conference on Hypertext, 1993, pp. 106-117.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price ("Linking By Inking: Trailblazing in a Paper-Like Hypertext") in

view of Golovchinsky ("From Reading to Retrieval: Freeform Ink Annotations as Queries") and Lawton ("The Knowledge Weasel Hypermedia Annotation System").

**As per claims 1-2 and 9-11**, Price discloses a system and method of processing documents stored a database, including a source document and a target document (See Price, Page 33, Column 2, paragraphs 4-5, and Page 34, Column 1, paragraph 1) including a search device for searching the target document to identify whether any words of interest are present in the target document (See Price, Page 34, Column 1, paragraph 3), and an annotation device for annotating the words located in the target document in the same manner that they were annotated in the source document, such as highlighting (See Price, Page 34, Figure 5). Price does not disclose expressly detecting one or more annotated regions in a source document, and inputting and storing a number of words of interest, each of the words stored as a result of being annotated in the source document. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate

information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claims 1-2 and 9-11. Additionally, Price does not disclose expressly that the source document and the target document are pre-selected from the database as the source document and the target document before the source document is annotated. Lawton discloses that a user selects various files of text, results and code and specifies that these are files to be annotated (See Lawton, Page 107, paragraph 7, lines 4-6). Lawton further illustrates the pre-selection of both a source and target file in a listing of annotation fields that are recorded in a database (See Lawton, Page 112, "Annotations", "Annotation Field", first two entries, "Source File" and "Target File"). Price, Golovchinsky and Lawton are analogous art because they are from the same field of endeavor of annotating documents. At the time of the invention it would have been obvious to one of ordinary skill in the art to include the pre-selection of a source and a target file for annotation of Lawton with the system and method of annotating documents of Price and Golovchinsky. The motivation for doing so would have been to allow related documents, such as documents being used for a tutorial in a classroom setting, to be annotated such that the annotations highlight the relationship between the source and target documents (See Lawton, Page 107, paragraph 7). Therefore, it would have been obvious to combine Lawton with Price and Golovchinsky for the benefit of allow related documents to be annotated such that the annotations

highlight the relationship between the source and target documents to obtain the invention as specified in claims 1-2 and 9-11.

**As per claims 3 and 12**, Price, Golovchinsky and Lawton disclose the limitations of claims 2 and 10 as described above. Price also discloses including a capture device for optically capturing a digital image of a physical source document (See Price, Page 35, Column 2, paragraph 6).

**As per claims 4 and 13**, Price, Golovchinsky and Lawton disclose the limitations of claims 3 and 11 as described above. Price also discloses detecting annotations in a captured image of the source document (See Price, Page 34, Column 1, paragraphs 2-3).

**As per claims 5 and 14**, Price, Golovchinsky and Lawton disclose the limitations of claims 4 and 13 as described above. Price also discloses detecting a type of annotation (See Price, Page 34, Column 1, paragraph 2).

**As per claims 6 and 15**, Price, Golovchinsky and Lawton disclose the limitations of claims 5 and 14 as described above. Price also discloses that the type of annotation detected includes one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring (See Price, Page 34, Column 1, paragraph 2).

**As per claims 7 and 16**, Price, Golovchinsky and Lawton disclose the limitations of claims 1 and 9 as described above. Price also discloses optically capturing a digital image of a physical target document to be annotated (See Price, Page 35, Column 2, paragraph 6).

**As per claim 18**, Price, Golovchinsky and Lawton disclose the limitations of claim 9 as described above. Price also discloses that the method is implemented by a set of program instructions stored in a storage medium and executable on a data processing device (See Price, Page 30, "Abstract").

**As per claim 19**, Price discloses a device implemented method of processing at least two documents including inputting a source document (See Price, Page 35, Column 2, paragraph 6, and Page 36, Column 1, paragraphs 1-2), inputting a target document, the target document pre-selected by a user of the device (See Price, Page 36, Column 1, paragraph 5). Price does not disclose expressly annotating the source document to identify a number of words of interest and storing the words of interest. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often



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users select each word to obtain the invention as specified in claim 19. Additionally, Price does not disclose expressly that the source document and the target document are pre-selected from the database as the source document and the target document before the source document is annotated. Lawton discloses that a user selects various files of text, results and code and specifies that these are files to be annotated (See Lawton, Page 107, paragraph 7, lines 4-6). Lawton further illustrates the pre-selection of both a source and target file in a listing of annotation fields that are recorded in a database (See Lawton, Page 112, "Annotations", "Annotation Field", first two entries, "Source File" and "Target File"). Price, Golovchinsky and Lawton are analogous art because they are from the same field of endeavor of annotating documents. At the time of the invention it would have been obvious to one of ordinary skill in the art to include the pre-selection of a source and a target file for annotation of Lawton with the system and method of annotating documents of Price and Golovchinsky. The motivation for doing so would have been to allow related documents, such as documents being used for a tutorial in a classroom setting, to be annotated such that the annotations highlight the relationship between the source and target documents (See Lawton, Page 107, paragraph 7). Therefore, it would have been obvious to combine Lawton with Price and Golovchinsky for the benefit of allow related documents to be annotated such that the annotations highlight the relationship between the source and target documents to obtain the invention as specified in claim 19.

**(10) Response to Argument**

Price and Golovchinsky disclose XLibris, an interface allowing a user to annotate a digital document with free-form ink where the computer system constructs hypertext links based upon the ink annotations. XLibris further propagates the annotations to a collection of documents (See Price, Page 30, "Abstract. Note also that the Price and Golovchinsky disclosures have the same authorship and address the same product, XLibris, See Golovchinsky, Page 19, Section 2.1).

Lawton discloses a hypermedia annotation system designed to support collaborative annotation, such as a group of people reading a book or attending a lecture and being able to make diverse comments and annotations to supplement the material (See Lawton, Page 106, "Introduction").

Appellant argues on Page 9 of the Brief that the Final Rejection has failed to provide some suggestion of motivation to combine the teachings of Lawton, Price and Golovchinsky.

The Office respectfully disagrees. The Office recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Final Office Action, filed 11 January 2006, states that at the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1).

The Final Office Action, filed 11 January 2006, also states that at the time of the invention it would have been obvious to one of ordinary skill in the art to include the pre-selection of a source and a target file for annotation of Lawton with the system and method of annotating documents of Price and Golovchinsky. The motivation for combining Lawton with Price and Golovchinsky would have been to allow related documents, such as documents being used for a tutorial in a classroom setting, to be annotated such that the annotations highlight the relationship between the source and target documents (See Lawton, Page 107, paragraph 7).

Appellant argues on Pages 9-10 of the Brief that the modification to the system and method of Price by the alleged teachings of Golovchinsky and Lawton to arrive at the claimed invention would render the system and method of Price unsuitable for their intended purpose as well as change their principle of operation.

The Office respectfully disagrees. The Advisory Action, filed 17 March 2006, addresses this argument, stating that while Price presents a system and method of searching for and locating related documents, and propagating annotations to said

related documents, there is no reason to omit the possibility that the data source from which these documents are selected is a finite collection of documents. Lawton also teaches that target documents may be obtained via search techniques, in the case of the Lawton disclosure, from a finite set of documents (See Lawton, Page 107, Paragraph 8), therefore further emphasizing the relationship between the system and method of propagating annotations to target documents obtained via a document search of Price and Golovchinsky, and the pre-selection of a source and a target document obtained via a document search of Lawton.

Appellant argues on Pages 10-11 of the Brief that Price's discussion of "Serendipity" on page 33, and of endnotes, or page 34, Columns 1 and 2, support the conclusion that the pre-selection of documents would render the system and method of Price unsuitable.

The Office respectfully disagrees and notes that the passages to which Appellant refers are merely examples of various uses of the disclosed system and method of Price, not limitations as to its use. Price teaches that XLibris supports reading and browsing over a wide variety of documents (See Price, Page 33, "Linking by Inking", first paragraph). There is no reason to infer by the teachings of Price that the collection of documents read and browsed may be limited to a finite collection of pre-selected documents, such as the collection of documents contained within a specific document database.

Appellant argues on Pages 11-12 of the Brief that a finite collection of documents, known to the user, would not require a query to search for documents based on a query if the target documents are already pre-selected and known to the system.


The Office respectfully disagrees. The Office maintains that a target document is pre-selected and known to the system if it exists within a finite collection of documents. Consider, for example, the United States Patents database – a collection of all United States Patent documents. This database represents a finite collection of documents, namely all United States Patent documents, pre-selected as only United States Patent documents and known to the user to be United States Patent documents. The user may choose to perform a search on the collection of documents prior to propagating the annotation to the target documents. The motivation for doing so would have been to determine how many documents in the collection contain the word or phase the user wishes to annotate so as to decide whether to annotate said documents based upon the number of documents returned by the query.

**(11) Related Proceeding(s) Appendix.**

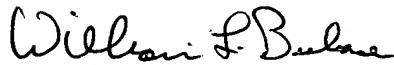
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

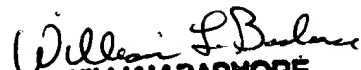
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

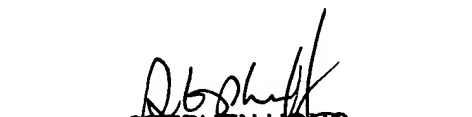
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